



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,351	01/20/1999	MARVIN L. WILLIAMS	WILLIAM-2	6210

7590 02/14/2003

HITT GAINES & BOISBRUN, P.C.
P.O. BOX 832570
RICHARDSON, TX 75083

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,351

Applicant(s)

WILLIAMS, MARVIN L.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Request for Reconsideration filed on 12/03/2002 to the application filed 01/20/1999.
2. Claims 1-27 are currently pending in this application. Claims 1-2, 5, 10-11,14, 19-20 and 23 have been amended by Applicant. Claims 1, 10, and 19 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al. (U.S. 6,029,164 – filed 09/1996) in view of **Applicant's Admitted Prior Art (APA)**.

As to independent claim 1, Birrell teaches an electronic mail program (e-mail; col.4, lines 21-31), a system (the mail service system; col.4, lines 6-15) for establishing relationships between hypertext references (a displayed message contains any “hot-links”; col.11, lines 54-63) contained in e-mail messages (email messages; col.4, lines 21-31) received by the e-mail program, comprising:

- a message parser (the message can be parsed; col.10, lines 36-48 / new messages received by the mail service system are stored, parsed in the message files; col.11, lines 29-38) that locates hypertext references in first and second e-mail messages received by the e-mail program (the first line of a displayed message contains any “hot-links” which the user can click to display the message ... with the HTML formatting; col.11, lines 54-63) and associated each of the hypertext references with a sender of the first and second e-mail messages; and

- a message organizer (organizing e-mail messages so that they can readily be located and retrieved; col.4, lines 16-31) that allows a user (users; col.4, lines 5-20) to choose to display the first and second e-mail messages in an order that is based on the hypertext references.

However, Birrell does not explicitly teach “associated each of the hypertext references with a sender of the first and second e-mail messages.”

APA teaches associated each of the hypertext references with a sender of the first and second e-mail messages (with the advent of the Internet and HTML, user could send hypertext information to each other within their e-mail message ...when the e-mail recipient selects the hypertext URL address contained in a given e-mail message, the e-mail recipient’s Internet browser can automatically seek out and display the associated information; Specification, page 2, lines 6-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. When receivers receive email message, they simply click on URL address associated with the messages to view the electronic documents.

As to dependent claim 2, Birrell teaches causing the e-mail program to display a message field containing the hypertext references (col.12, lines 1-13) and a from field containing the sender associated with each of the hypertext references.

However, Birrell does not explicitly teach “ a from field containing the sender associated with each of the hypertext references.”

APA teaches a from field containing the sender associated with each of the hypertext references (with the advent of the Internet and HTML, user could send hypertext information to each other within their e-mail message ...when the e-mail recipient selects the hypertext URL address contained in a given e-mail message, the e-mail recipient's Internet browser can automatically seek out and display the associated information; Specification, page 2, lines 6-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. When receivers receive email message, they simply click on URL address associated with the messages to view the electronic documents.

As to dependent claim 3, Birrell teaches the first e-mail message is selected from the group consisting of: a direct e-mail message, and a newsgroup posting (col.1, lines 33-38).

As to dependent claim 4, Birrell teaches the hypertext references have associated viewing statuses, the message organizer identically marking viewing statuses of identical ones of the hypertext references (col.10, lines 1-48).

As to dependent claim 5, Birrell teaches the message organizer_(organizing e-mail messages so that they can readily be located and retrieved; col.4, lines 16-31) orders based on the hypertext references and the sender associated with each of the hypertext references.

However, Birrell does not explicitly teach orders based on the hypertext references and the sender associated with each of the hypertext references.

APA teaches orders based on the hypertext references and the sender associated with each of the hypertext references (with the advent of the Internet and HTML, user could send hypertext information to each other within their e-mail message ...when the e-mail recipient selects the hypertext URL address contained in a given e-mail message, the e-mail recipient's Internet browser can automatically seek out and display the associated information; Specification, page 2, lines 6-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. When receivers receive email message, they simply click on URL address associated with the messages to view the electronic documents.

As to dependent claim 6, Birrell teaches the hypertext references are uniform resource locators (col.12, lines 1-14).

As to dependent claim 7, Birrell teaches the message organizer allows the user to view referenced resources according to the order (col.10, lines 1-7).

As to dependent claim 8, Birrell teaches a browser and the message organizer is capable of employing the browser to view information associated with the hypertext references (col.12, lines 1-67).

As to dependent claim 9, Birrell teaches the browser is capable of paging between pages of information associated with the hypertext references of the message organizer and the browser identically marks viewing statuses of identical ones of the hypertext references (col.10, lines 1-8 / col.11, lines 54-63).

Independent claim 10 is for a method presenting the system of claim 1, and is similarly rejected under the same rationale.

Dependent claims 11-18 include the same limitations as in claims 2-9, and are similarly rejected under the same rationale.

Independent claim 19 is directed to a program for performing the system of claim 1, and is similarly rejected under the same rationale. However, the claim 19 further recites:

- a message receiver;
- a message transmitter coupled to the message receiver;
- a message composer coupled to the message transmitter;
- a message store coupled to the message composer.

Birrell teaches:

- a message receiver (the messages were received; col.11, lines 4-38 / the message has been received; col.12, lines 38-44)
- a message transmitter (send a message; col.14, lines 50-54) coupled to the message receiver;

- a message composer (compose begins a new message; col.14, lines 15-33) coupled to the message transmitter; and

- a message store (new messages are stored; col.11, lines 29-38) coupled to the message composer.

As to dependent claims 20-27 include the same limitations as in claims 2-9, and are similarly rejected under the same rationale.

Response to Arguments

4. Applicant's arguments filed on December 03, 2002 have been fully considered but they are not persuasive.

The broad claim limitations used in the application continues to read on the references presented in the previous office action.

Applicant argues that *the Examiner admitted that Birrell does not explicitly teach "associate[s] each of the hypertext references with a sender of the first and second e-mail messages.* (Remarks, page 2, lines 8-9)

The Examiner agrees. However, APA is used to teach these limitations as detailed in the Office Action.

Applicant argues *The Examiner further stated it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of the Applicant's background with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. The Applicant respectfully disagrees.* (Remarks, page 2, lines 12-16)

In response, Applicant fails to explain why the teachings of APA and Birrell can not be combined. The Examiner believes that the combination of Birrell and APA meets the limitations as broadly claimed by Applicant.

Applicant argues *expressing the Examiner's argument in the form of a syllogism, the Examiner is asserting that: (1) because an e-mail contains a sender, (2) and because hypertext references are in an e-mail, (3) hypertext references are necessarily associated with the sender. Unfortunately, this syllogism is inductive and therefore improper. The Examiner is attempting to use first and second Minor Premises to induce a Major Conclusion, rather than adhering to proper syllogistic form by using a Major Premise and a Minor Premise to deduce a valid Minor Conclusion. The Examiner's Major Conclusion is therefore unsupportable and improper. The contents linked by the hypertext references do not have to be associated with a sender of an e-mail message. The hypertext reference can be associated with something completely unrelated to the sender.* (Remarks, page 3, line15-page 4, line 1)

Contrary to Applicant's contention, the syllogism is proper. Applicant fails to explain what is *something completely unrelated to the sender.*

As to dependent claims 2-9, 11-18, and 20-27, the arguments are not persuasive for reason as discussed above with regards to independent claims 1, 10, and 19.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davis et al.

U.S Patent No. 5,937,160

issued dated: Aug. 10, 1999

Kumar et al.	U.S Patent No. 6,240,445	issued dated: May 29, 2001
Freivald et al.	U.S Patent No. 6,012,087	issued dated: Jan. 4, 2000
Van Dusen	U.S Patent No. 6,175,823	issued dated: Jan. 16, 2001

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 8:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Art Unit: 2176

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.


OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhánh nguyen
February 10, 2003.


JOSEPH H. FEILD
PRIMARY EXAMINER